

REMARKS

Claims 12, 15-17, 22, 33, 44-46, 51 and 56 have been amended. These amendments have been made to improve the consistency of terminology within these claims. No new matter has been added. Claims 1 – 56 are pending in this application.

Objections to Information Disclosure Statement

Applicants acknowledge the Examiner's objection to references that were listed on the PTO Form 1449 previously filed on January 23, 2003, but that were not found in the collection of hard copies provided. Submitted herewith are a Supplemental Information Disclosure Statement, PTO Form 1449, and copies of twelve cited references. The cited references correspond to "Cite No." 141, 142, 251, 357, 365, 370, 380, 384, 441, 461, 489 and 518 in the previously filed PTO Form 1449. Applicants point out that copies of the references for "Cite No." 312, 320, 327, 439 and 440 were apparently provided in the previous submission, as these were inadvertent duplicate entries for "Cite No." 90, 108, 165, 472 and 473, respectively.

Rejection under 35 U.S.C. § 112, 1st paragraph

Claims 1-14, 18-21, 23-31 and 52-56 were rejected under 35 U.S.C. § 112, 1st paragraph as not enabled. The Office Action asserts that Applicants' specification requires an acrylic acid monomer unit in a sulfonate anion modified polymer, and that the presence of an acrylic acid monomer unit must be recited in the claims.

The rejection of the claims under 35 U.S.C. § 112, 1st paragraph is respectfully traversed. The specification lists a number of ion-sensitive polymers that can be used in water-dispersible binders as recited in the claims. These ion-sensitive polymers include, for example, acrylic acid terpolymers and sulfonate anion modified acrylic acid

terpolymers, as well as acrylic acid free polymers [p. 9, lines 22-36]. The disclosure of the acrylic acid free polymers refers to U.S. Patent Application Serial No. 09/565,623, which has now issued as U.S. Patent No. 6,537,663 and which was incorporated by reference into the present application. This patent describes ion-sensitive hard water dispersible polymers containing 2-acrylamido-2-methyl-1-propanesulfonic acid (AMPS), butyl acrylate, and/or 2-ethylhexyl acrylate, but which are substantially free of acrylic acid and methacrylic acid monomers or their polymerization products [col. 6, lines 15-20]. Thus, the specification adequately discloses sulfonate anion modified polymers that do not contain acrylic acid.

The use of sulfonate anion modified polymers containing acrylic acid monomeric units is described in Applicants' specification as a desired embodiment. However, there is nothing in the specification that states that monomeric units derived from acrylic acid are critical or essential to the claimed invention, nor is there any language in the specification that excludes the use of acrylic acid free polymers. This includes the portions of the specification cited in the present Office Action. As noted in the MPEP,

In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. ...

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

[MPEP § 2164.08(c); emphasis and ellipses added]

Applicants submit that the specification presents a broad description of sulfonate anion modified polymers that may or may not contain acrylic acid monomeric units, and the presence of acrylic acid monomeric units cannot be held to be critical or essential.

Accordingly, claims 1-14, 18-21, 23-31 and 52-56 fully meet the requirements of 35 U.S.C. § 112, 1st paragraph, and Applicants request that this rejection be withdrawn.

Double Patenting

Claims 1-52 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-46 of U.S. Patent No. 6,579,570. This rejection is obviated by the filing of an appropriate terminal disclaimer. Pursuant to 37 CFR 1.130(b), a terminal disclaimer pursuant to 37 CFR 1.321(c) with respect to U.S. Pat. No. 6,579,570 is filed herewith. The present application and U.S. Pat. No. 6,579,570 are commonly owned by Kimberly-Clark Worldwide, Inc.

Claims 1-52 were rejected under the judicially created doctrine of obviousness-type double patenting over unspecified claims of copending application Serial No. 09/564,837. Applicants note that this application has now issued as U.S. Patent No. 6,599,848. This rejection is obviated by the filing of an appropriate terminal disclaimer. Pursuant to 37 CFR 1.130(b), a terminal disclaimer pursuant to 37 CFR 1.321(c) with respect to U.S. Pat. No. 6,599,848 is filed herewith. The present application and U.S. Pat. No. 6,599,848 are commonly owned by Kimberly-Clark Worldwide, Inc.

Provisional Double Patenting

Claims 1-52 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 26 and 28 of copending application Serial No. 09/900,698.

Claims 1-52 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 74, 75, 91, 100, 131 and 134 of copending application Serial No. 09/565,125.

In accordance with MPEP § 804(I.)(B), Applicants request that these rejections be withdrawn. The copending application Serial Nos. 09/900,698 and 09/565,125 have

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not yet issued. If the provisional double patenting rejections are the only rejections remaining in the present application, Applicants request that the present application be allowed to issue.

CONCLUSION

In conclusion, all of the grounds raised in the present Office Action for rejecting the application are believed to be overcome or rendered moot based on the remarks above. Thus, it is respectfully submitted that all of the presently presented claims are in form for allowance, and such action is requested in due course. Should the Examiner feel a discussion would expedite the prosecution of this application, the Examiner is kindly invited to contact the undersigned.

Also submitted at this time is a Petition For Extension of Time for one (1) month.

Respectfully submitted,

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